

Appln No. 09/650,482

Amdt date September 7, 2004

Reply to Office action of March 4, 2004

REMARKS/ARGUMENTS

Claims 1-27 are pending in the present application. No new amendments are presented. In the Office action dated March 4, 2004 (the "present Office action"), Claim 1 was rejected under §103 over (US 5,737,539) Edelson et al (hereinafter, Edelson) in view of (US 5,924,074) Evans. Claims 2-15 were rejected under §103 over Edelson in view of (US 5,845,255) Mayaud. Claims 16-27 were rejected under §103 over (US 5,758,095) Albaum et al. (hereinafter, Albaum) in view of Edelson and in view of Official Notice.

Applicants Previous Arguments and the Examiner's Response to Such Arguments

In the first Office action on this application, dated September 10, 2003 (the "First Office Action"), claims 1-15 were rejected under §103 over Mayaud in view of Evans. As in the present Office action, claims 16-27 were rejected under §103 over Albaum in view of Edelson and in view of Official Notice. Applicants filed arguments in a response with no amendments on December 10, 2003 (the "First Response").

The present Office action, though, does not address most of the arguments presented in the First Response. In the present Office action, the Examiner does include a section titled, "Response to Arguments." Present Office action at 18-19. However, this section only specifically addresses applicants' arguments regarding claims 8-9 and 11-13 (and by implication similar rejections to claims 18-23 and 26-27). Present Office

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action at 18. This section also includes a general discussion of motivation/suggestion that appears to be directed to the rejections based on Official Notice, but this is not made clear. Present Office action at 18-19. With respect to the other claims (claims 1-7, 10, 14-17 and 24-25), the Examiner merely states, "[t]he other arguments are 'moot' in view of the new ground(s) of rejection above." Present Office action at 18. For most of the claims, including claim 1, though, applicants find no new grounds of rejection stated in the present Office action and accordingly, reconsideration of these arguments and a new action addressing these arguments is respectfully requested.

Claim 1

In the First Response, with respect to claim 1, applicants argued, "Evans does not describe or suggest supplying a formulary record or a service center server supplying the pharmacy server a formulary record 'upon request by a pharmacy client system when a order is processed' provided for in claim 1." First Response at 3. Applicants further argued that the Examiner did not make out a *prima facie* showing of obviousness because Evans and Edelson both disclose complete solutions that would not have any need or motivation to be combined with each other or any other system and that there is not teaching or suggestion as to how these systems of these two references could even be combined to arrive at the claimed invention. *Id.* These arguments were not addressed at all in the present Office action.

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More specifically, claim 1 was rejected in the First Office Action as obvious over Mayaud in view of Evans. In the present Office action, claim 1 is rejected over Edelson in view of Evans. Indeed, the text of the Examiner's rejection using Mayaud appears to be word-for-word identical to the rejection using Edelson except for updates in the column and line references to Edelson rather than Mayaud. Thus the only change is switching Edelson for Mayaud from the previous rejection. It is noted, however, that Mayaud is a continuation (not a continuation-in-part) of the earlier filed Edelson. As a continuation and parent, they have the same disclosures.¹ Thus, with respect to claim 1, the "new grounds of rejection" are truly identical to the grounds for rejection in the First Office Action and thus applicants' arguments in the First Response regarding claim 1 are not "moot" as they have not yet been addressed by the Examiner at all.

Dependent Claims 2-15

With respect to claims 2-15, in the First Office action, the rejection was based on Mayaud in view of Evans, while the rejection of these claims in the present Office action is based

¹ Mayaud adds some method flowcharts in new Figures 17-21 that appear to be supported by the original Edelson disclosure as the only change in the text of the disclosure in Edelson found in Mayaud is adding reference numerals to new figures - however, as the examiner switched backwards from the continuation with the new figures to the parent without the new figures, this point is moot.

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on Edelson in view of Mayaud. It is believed that this may be an inadvertent error because, as discussed above, Edelson and Mayaud contain the same disclosure and combining two identical disclosure to make an obviousness rejection would not appear to make sense (see, e.g., the rejection of claim 5 wherein the Examiner states that Edelson fails to teach an element that the Examiner states is taught in Mayaud). It is noted that for most of claims 2-15, the text of the rejections in the present Office action are the same as the text of the rejections in the First Office action with Mayaud replaced by Edelson. Accordingly, the Examiner may have intended to replace the rejection based on Mayaud and Evans with a rejection based on Edelson and Evans rather than a rejection based on Mayaud and Edelson, but this is speculation on applicants' part.² However, even if the Examiner intended to reject claims 2-15 based on Edelson in view of Evans as with claim 1, simply replacing Mayaud with Edelson, this rejection appears to be the same as the rejection in the First Office action because Edelson and Mayaud have the same

² The Examiner did add new text to the rejections of dependent claims 5, 6, 7, 10, 14 and 15. These new "grounds" for rejection are fatally flawed because of the apparent mistake of combining Mayaud and Edelson rather than Edelson and Evans. Thus, for each of these claims, the Examiner presents an argument where she asserts that Edelson fails to teach a claimed element, but Mayaud teaches this element and then she recites language taken (but not identified as a quote) from Edelson/Mayaud (the Office action does not identify the source, but the language is found identically in both references) as suggesting modifying Edelson with the teaching of Mayaud. Of course, as Mayaud and Edelson are the same exact disclosures, such arguments do not make sense and applicants cannot coherently respond to them.

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disclosure as discussed above. Thus, the "new" rejection does not moot or address Applicants' arguments in their First Response with respect to claims 2-15.

In particular, the Examiner does not address applicants' specific arguments in the First Response that the elements in claims 6, 7, 10, 14 and 15 are not disclosed in Mayaud as asserted by the Examiner in the First Office Action. Merely changing the citation of where these elements are supposedly found from Mayaud to Edelson, when Mayaud and Edelson have identical disclosures does not address applicants' arguments.

Dependent Claims 16-27

With respect to claims 16-27, the rejection on the present Office action appears to be the same as the rejections of claims 16-27 in the First Office Action. As such, applicants fail to understand how these are new grounds of rejection and how they address applicants' arguments made in their First Response at pages 16-19. Upon further analysis, though, in addition to the arguments made in the First Response, applicants note that they mistakenly understood the rejection of claims to read Albaum on the elements of claim 1. From a closer reading of the rejection, it appears that Albaum is merely applied to the elements recited in claim 16, but is not applied to the elements of claim 1 upon which claim 16 is dependent. Thus, in addition to the reasons set forth in the First Response, the rejection of claim 16 (and claims 17-27 dependent thereon) are improper as the examiner has not even alleged that it would have been

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obvious to combine combination of Albaum and Edelson and Official Notice (claim 16 rejection) with the combination of Edelson or Mayaud in view of Evans (claim 1 rejections), not to mention the corresponding lack of showing of any motivation or suggestion for such combination.

Official Notice and Motivation/Suggestion

With respect to dependent claims 8-9, 11-13, 18-23 and 26-27, applicants refuted the Examiner's reliance on Official Notice that it would be obvious to modify the cited reference with the claimed elements as improper under both the MPEP and case law. See, First Response at 7-9. This argument quoted current sections of the MPEP (§2144.03) and current controlling case law (*In re Lee*, Fed. Cir. 2002 and *In re Zurko*, Fed. Cir. 2001). It is important to note that applicants' argument with respect to the Examiner's use of Official Notice is that the Examiner improperly uses Official Notice for *both* teachings of the claimed elements and the motivation to combine these teachings with the cited references.

In response, the Examiner cites several outdated CCPA cases, including one case that was expressly disapproved by the Federal Circuit for the proposition the Examiner relies upon in the very case that applicants cited in the First Response, *In re Lee*. Present Office action at 18-19. In this discussin, the Examiner first accurately states that suggestion or motivation does not to be expressly stated in one or all of the references (citing *Cable Products* (Fed. Cir, 1985) and *In re Scheckler* (CCPA

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1971)). The Examiner then continues that "the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference[s]. [citing *In re Bode* (CCPA 1977) and *In re Jacoby* (CCPA 1962)]." The examiner then concludes by quoting *In re Bozek* (CCPA 1969) that "[a] conclusion of obviousness is established 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.'" This principal was explicitly rejected in *In re Lee*, 61 U.S.P.Q. 2d 1430, 1434-5 (Fed. Cir. 2002). Specifically the Federal Circuit stated that "Bozek did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Bozek did not hold that objective analysis, proper authority, and reasoned findings can be omitted from Board[/Examiners'] decisions." *Id.*, at 1435. The Federal Circuit, in *In re Lee*, reaffirmed its long line of cases that require a showing of a suggestion, teaching or motivation to combine prior art references in an obviousness holding. *Id.* at 1433. In the present Office action, throughout the action, the Examiner routinely asserts essentially that combining reference A with B would have been obvious because it would be advantageous to have an element of B combined with reference A. This is exactly the type of conclusory reasons that "use that which the inventor taught against its teacher" specifically rejected by the Federal Circuit in *In re Lee*. *Id.* at 1434. (Insufficient showings include: "[T]he demonstration mode is just a programmable feature which can be used in many different device[s] for

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providing automatic introduction by adding the proper programming software." "[A]nother motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial.").

The Examiner's only comments directed to any specific claims in which Official Notice was used were directed to claim 9. The Examiner stated, "[t]he evidence is in the On-Line Medical Dictionary reference listed in the prior art made of record in the Office Action of 09/10/03 [the First Office action] which Applicants' are respectfully requested to read." Present Office action at 18.

Before addressing claim 9, it is noted the Examiner asserts that the arguments with respect to claims 11-13 are addressed in response to the argument regarding claim 9. Present Office action at 18. This is simply not the case. In fact, the Examiner's argument does not even address claim 8 as it purports to do. Applicants also note that Examiner does not even mention applicants' Official Notice arguments made with respect to claims 18-23 and 27. The citation to the On-Line Medical Dictionary in the First Office Action is to a definition of "electrolytes." With respect to claim 8, the Examiner has not made out a *prima facie* case of obviousness because she has not provided any evidence as to the relationship between properties of electrolytes in the cited dictionary definition and updates to formulary records that include modifications to caloric content in claim 8. Present Office action at 6-7. Similarly, applicants fail to see the relevance of the definition of "electrolytes" to the Official Notice taken with respect to

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claims 11-13, and 18-23, which include elements that include subject matter other than electrolytes. With respect to claim 27, while it relates to electrolytes, the cited dictionary definition is irrelevant to validation of medications by comparing modifications to predetermined amounts of electrolytes in predefined medications as recited in claim 27. It is not known whether the Examiner is contending that support for the Official Notice taken with respect to the subject matter of each of claims 8, 11-13, 18-23 and 27 is found somewhere else in the On-Line Dictionary. If so, it respectfully suggested that it is the Examiner's burden to point to which terms in the 46,000 term dictionary are relied upon for which claim in such Official Notices (MPEP §2144.03.C).

Returning the Official Notice with respect to claim 9, applicants respectfully traverse the Examiner's rejection. The entirety of the On-Line Dictionary reference cited by the Examiner is a 28 word definition of "electrolytes," namely, "[s]ubstances that dissociate into two or more ions, to some extent, in water. Solutions of electrolytes thus conduct an electric current and can be decomposed by it (electrolysis)." The Examiner's entire stated grounds for rejection, presumably including the required showing of motivation/suggestion, is that "it would have been obvious . . . to have the modification to the ingredients of the medication to include modifications to electrolytes in the medication because such a modification in Edelson would allow Edelson to have substances that dissociate into two or more ions, to some extent, in water." First, this definition of electrolytes does not disclose the element in

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claim 9, namely, "wherein updates to the modification to the ingredients of the medication [in updates to the formulary records (antecedent from claim 7)] include changes to the amounts and preferences of electrolytes in the medication," but rather simply gives a known property of electrolytes generally. Second, this "ground" is completely circular and thus logically flawed. As the phrase "substances that dissociate into two or more ions to some extent, in water" is the definition of the word "electrolytes," provided by the cited On-Line Dictionary definition, this phrase and this word are interchangeable. When this phrase in the Examiner's ground for rejection is replaced with the word "electrolytes, the Examiner's ground becomes, "it would have been obvious . . . to have the modification to the ingredients of the medication to include modifications to electrolytes in the medication because such a modification in Edelson would allow Edelson to have electrolytes." This is not a motivation or suggestion to combine references, but rather just an assertion that it would be obvious to modify Edelson to add feature X because this would allow Edelson to have X. This is the epitome of using hindsight and the teachings of the application as the basis for rejecting the claims. It is noted that this same form of logic and rejection is apparently also used for each of claims 8, 11-13, 18-23 and 26-27 and such rejections are improper for the same reason.

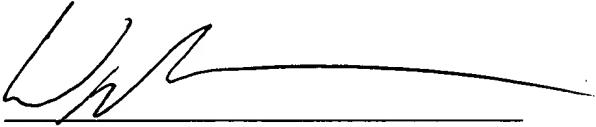
Accordingly, it is respectfully submitted that the arguments in applicants' First Response have not yet been fully considered in the present Office action. Further, the "new" grounds for rejection are all fatally defective as described in

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detail above. Last, the Examiner's statement of the legal standards for the required showing for motivation/suggestion to combine references in an obviousness rejection and the use of "common knowledge" as "evidence" is incorrect and the correct legal standard was not applied in the present Office action. For these reasons, it is respectfully requested the rejections in the Office action dated March 4, 2004 be reconsidered and the above comments as well as the comments in applicants' response dated December 10, 2003 be fully considered. If the Examiner has any questions or would like to discuss the application and/or prior art prior to the issuance of a further Office action, the Examiner is invited to contact the undersigned by telephone.

Respectfully submitted,
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